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10/807,411

03/24/2004

Frank Muir

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12/19/2008

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EXAMINER

DANIELS, MATTHEW J

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,411	<b>Applicant(s)</b> MUIR, FRANK	
	<b>Examiner</b> MATTHEW J. DANIELS	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-11,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-11,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 7, 8, 9, 10, 11, 17, 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (US 2,635,289) in view of Mitchell (US 2,427,870).

The Examiner submits that Owens' annular shape is suitable for engaging a bottle alone or in combination with Mitchell, and therefore meets all intended use limitations drawn to engaging of bottles or serving as a bottle cap. **As to Claim 1**, Owens teaches: A method of making a bottle cap with a built-in magnification feature (Figs. 20-30), comprising the steps of selecting a radius of curvature (inherent in that a radius is provided), pressing a single piece of plastic (Figs. 62, 63, see "a plastic sheet" at 3:26) into the shape of a bottle cap having a top portion (Fig. 30, Items 284,281) and an annular bottle engaging portion (Fig. 30, Items 286,285) which includes a mounting member for selectively affixing the lens to an object, wherein said at least one of said upper or lower convex surfaces of each bottle cap has a radius of curvature (many of the elements of Owens would have a radius so as to magnify, see the figures) so as to provide optical magnification of objects through said top portion.

Owens does not explicitly disclose (a) different radii being selected, and (b) the use of a lid wall with an inwardly projecting hoot region at its base for selectively fixing the article to

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another object. However, these aspects of the invention would have been prima facie obvious for the following reasons:

- (a) Owens clearly instructs the ordinary artisan to provide a “size and shape wanted in the finished element” at 32:30-31. The process is applied to various optical instruments including telescopes, magnifying glasses, etc. (3:7-11, 3:50-53, 6:23-32, and Fig. 58). In view of the Owens references, it would have been obvious to provide lenses having different radii of curvature in order to provide various magnifications and articles having various different sizes.
- (b) Owens recognizes that the structure must be mounted using some mounting structure (Figs. 25, 26, 29, 30, 30A, etc.) but is silent to the particular claimed mounting structure. However, Mitchell teaches a similar device including the use of a lid wall with an inwardly projecting hook region (Figs. 3 and 4, item 21) for use with a lens which is mounted as a cover. Mitchell suggests that various sizes may be provided, from a hand operated size to one of such substantial size as to make hand operation inconvenient (3:29-35).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Mitchell into that of Owens for the following reasons:

- (a) Owens provides a process for fabricating lenses from “Lucite” or other methacrylate resins with various mounting features (6:35-39 and Figs. 20-30A), many of which provide the lens mounts to be placed on or over the support structure (Fig. 26, item 246, Fig. 24, item 237, Fig. 30A, item 290). Mitchell provides lenses made from methacrylate resins such as “Lucite” with a mounting means (Fig. 3, item 21). In view of the similar materials of the Owens and Mitchell lenses and the requirement in each reference that a mounting feature be provided, it is submitted that the mounting means of Mitchell represents a substitutable mounting means for a lens, and

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that one of ordinary skill in the art could have substituted one known mounting means (Mitchell) for another (Owens) to provide the predictable result that the Owens device would merely be securely mounted by a different mounting mechanism. Therefore, the ordinary artisan would have found it obvious to perform a simple substitution of the Owens mount for the hook shaped channel disclosed by Mitchell since both are recognized in the art as known mounting features for lens structures.

(b) Owens provides a process for fabricating lenses from “Lucite” or other methacrylate resins with various mounting features (6:35-39 and Figs. 20-30A), thereby suggesting that some mounting feature is desirable on a “Lucite” lens. Mitchell provides lenses made from methacrylate resins such as “Lucite” with a mounting means (Fig. 3, item 21), showing that there would be a reasonable expectation of success in using the mounting device of Mitchell with the Owens process. Since Mitchell teaches the channel or hook shape as desirable for mounting this type of lens, one of ordinary skill in the art at the time of the invention would have been motivated to incorporate the Mitchell mount into the Owens method in view of Owens’s suggestion to use a mount and in view of the lens mount provided by Mitchell for use with a similar material.

**As to Claim 2**, Owens teaches the pressing step is achieved using a stamping machine (Figs. 1 and 2). **As to Claim 7**, by the multitude of elements shown in the figures of Owens, it is asserted that Owens clearly recognizes the particular radii of curvature to be a result-effective variable which can be modified and optimized. Additionally, Owens teaches that the upper and lower surfaces are convex and have an equal radius of curvature (Figs. 25 and 40, for instance). **As to Claim 9**, Owens teaches a flat surface and a convex surface (Fig. 20). Although silent to

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the top and bottom surfaces, this is a matter of orientation, and Owens' Fig. 20 meets the claimed limitation. **As to Claims 10 and 11**, Owens teaches plastic as an optical lens, which would have inherently have been transparent and translucent (Title, 4:14, 11:69-12:33). These terms appear to overlap in scope. **As to Claim 17**, Mitchell provides an upper convex surface which has a perimeter that extends to an edge of the engaging portion (lens extends over mount, 21). One would have been motivated to incorporate the extending lens of Mitchell into that of Owen in order to increase the field of view by mounting to the outside of a tube. **As to Claim 18**, Owens' process is simultaneous, and forms one or two convex surfaces (see the figures).

2. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Mitchell (US 2,427,870), and further in view of Harris (USPN 4401434). Owens and Mitchell teach the subject matter of Claim 1 above under 35 USC 103(a).

**As to Claim 17**, Owens appear to be silent to the particular configuration, however, the Examiner takes the position that Harris provides a lens having convex surfaces and a perimeter which extends to an edge of the annular bottle engaging portion (Fig. 5, items 64, 28, and 12). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Harris into that of Owens in order to provide a kit which is easy to manufacture and market (2:12-14), adapted for easy storage and maintenance of all the components needed in a single location (2:1-11), maintaining the viewer in a convenient position (2:29-40), and providing the largest possible magnifier in the lid to maximize the effect of the invention.

***Response to Arguments***

3. Applicant's arguments filed 17 September 2008 have been fully considered but they are not persuasive. The arguments appear to be on the following grounds:

a) The Board of Appeals looked at the claimed invention which was drawn to a method of making bottle caps. The Mitchell reference describes a paper weight. But neither of the references describes a bottle cap.

b) The Mitchell reference does not show either selecting a radius of curvature or pressing. However, Mitchell does not disclose the ability to press Lucite into a bottle cap shape or the shape of a paper weight. Given the thickness of the paper weight shown in Figs. 2 and 3, it would simply be incorrect to conclude that anything was pressed into shape from Mitchell.

4. These arguments are not persuasive for the following reasons:

a,b) The arguments are drawn, in part, to the intended use. However, it is submitted that there are no reasons presented as to why the Owens device could not be used as a bottle cap. On page 6 of the opinion by the Board of Patent Appeals and Interferences mailed 13 August 2008, it was noted that:

Appellants have not explained, much less demonstrated, how or why the claimed "bottle cap" is structurally distinguishable from the annular shape mounting device having a built-in magnification feature taught by Owens (Compare Ans. 3, with Br. 15-17).

The present arguments do not appear to cure this deficiency with respect to the rejection over Owens.

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Applicant's arguments do not appear to dispute the factual determination that Mitchell provides a hook region which reads on the claimed invention. Thus, the dispositive question with respect to the pending claim and the rejection over Owens and Mitchell is believed to be substantially the same as set forth on Page 9 of the 13 August 2008 opinion by the Board: whether one of ordinary skill would have looked to the disclosure of Mitchell to improve the mounting device for optical instruments taught by Owens.

With respect to the Towns reference, the opinion by the Board stated that it was not demonstrated that one of ordinary skill in the art would have looked to soda bottle cap features (from Towns) to improve mounting devices for optical instruments, such as those taught by Owens. However, the Mitchell reference provides an optical device in the form of a lens member. (Mitchell, col. 2, ll. 5-17). The lens member comprises a transparent cylindrical lens formed of transparent resin such as "Lucite" or "Plexiglass" or any other suitable transparent material. (Mitchell, col. 1, ll. 50-54). In fabricating his lenses (Owens, col. 5, ll. 55-60), one resin which he had great success using is "Lucite." (Owens, col. 6, ll. 35-39). It is submitted that one of ordinary skill in the art at the time of the invention having knowledge of the Owens process would have indeed looked to Mitchell for alternative or substitutable mounting means in view of the similar materials, components (lenses with mounting means), and similar functions (mounting of lenses).

In response to applicant's arguments against the references individually, in this case Mitchell's alleged failure to teach a compression molding process or selecting a radius of curvature, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208



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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The argument fails to acknowledge the relevant factual findings set forth on pages 4 and 5 of the opinion by the Board pertaining to the Owens reference.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. DANIELS whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/  
Primary Examiner, Art Unit 1791  
11/28/08